

REMARKS

Claims 1-7 are pending in the application. Claim 1 has been amended herein. Favorable reconsideration of the application, as amended, is respectfully requested.

I. CLAIM REJECTIONS

- a. Claims 1-7 stand rejected based on obviousness-type double patenting in view of claims 1-4 of U.S. Patent No. 6,661,746 (the '746 patent).
- b. Claims 1-7 stand provisionally rejected under 35 USC §101 as claiming the same invention of claims 1, 4, 8 and 10 of copending Application No. 09/999,047 (the '047 application).
- c. Claims 1-7 further stand rejected under 35 USC §101 as directed to non-statutory subject matter.

Applicants' Response:

- a. Applicants submit herewith a Terminal Disclaimer in relation to the '746 patent. Consequently, applicants respectfully request that the rejection be withdrawn.
- b. Applicants note that the Examiner provisionally rejects claims 1-7 under 35 USC §101 on the basis that the claims are directed to the same invention as claims 1, 4, 8 and 10 of the '047 application. However, the Examiner acknowledges that claim 1 of the present application includes the features of "wherein the first reproduction path information comprising ...; and the second reproduction path information comprising...", whereby claim 1 of the '047 application does not include such features. The Examiner indicates that such differences in the claims would have been obvious in view of Kenner et al. (See, e.g., O.A., pgs. 9-10).

Without commenting on the merits of the rejection, applicants note that a double patenting rejection under 35 USC §101 is applicable in the case where the applicant

has two claims directed to the same invention. It is not necessary that the claims be completely identical; however, it is required that the claims be directed substantively to the same invention. By the Examiner's own admission, the claims are different substantively in that claim 1 of the present application includes the features of "wherein the first reproduction path information comprising ...; and the second reproduction path information comprising...", whereby claim 1 of the '047 application does not include such features. Therefore, the basis of rejection under 35 USC §101 is improper.

On the other hand, the Examiner may still feel justified in arguing that claim 1 of the present application is simply an obvious variation of claim 1 of the '047 application. Applicants do not agree with the Examiner in such case, but respectfully submit that the correct basis for such rejection is under the judicially created doctrine of obviousness-type double patenting. Since the basis for the rejection is more properly under the judicially created doctrine of obviousness-type double patenting (rather than 35 USC §101 double patenting), such rejection may be overcome with a timely filed Terminal Disclaimer.

In the interest of expediting favorable prosecution, applicants submit herewith a Terminal Disclaimer in relation to the '047 application. However, applicants note that Application No. 09/999,047 (the '047 application) is the application that resulted in the U.S. Patent No. 6,661,746 (the '746 patent). Thus, the aforementioned Terminal Disclaimer in relation to the '746 patent would similarly overcome the provisional rejection based on the '047 application.

c. Regarding the rejection of claims 1-7 on the basis of being directed to non-statutory subject matter, applicants have adopted the Examiner's suggestion for amending claim 1. Thus, withdrawal of the rejection is respectfully requested.

II. CONCLUSION

Accordingly, all claims 1-7 are believed to be allowable and the application is believed to be in condition for allowance. A prompt action to such end is earnestly solicited.

Should the Examiner feel that a telephone interview would be helpful to facilitate favorable prosecution of the above-identified application, the Examiner is invited to contact the undersigned at the telephone number provided below.

Should a petition for an extension of time be necessary for the timely reply to the outstanding Office Action (or if such a petition has been made and an additional extension is necessary), petition is hereby made and the Commissioner is authorized to charge any fees (including additional claim fees) to Deposit Account No. 18-0988.

Respectfully submitted,

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